

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Basil Naji et al.
Serial No. : 10/090,561
Filing Date : March 4, 2002
Group Art Unit : 1793
Confirmation No. 5549
Examiner : Marcantoni, Paul D.
For : Coatings for Building Products and Methods of Making Same

VIA EFS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION FOR WITHDRAWAL OF THE RECORDED TERMINAL DISCLAIMER
(SUBMITTED UNDER 37 C.F.R. 1.182)**

Dear Sir:

Applicants submit this Petition for Withdrawal of the Recorded Terminal Disclaimer in order to nullify or otherwise cancel the effect of recorded terminal disclaimer that was erroneously filed before the patent issues. As such, this paper respectfully requests nullification of recorded terminal disclaimer by way of petition for the reasons set forth below as is allowable [see *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968)].

A terminal disclaimer was submitted erroneously on or about June 23, 2005, with pending U.S. Patent Application No. 10/090,561 (hereinafter "the '561 application") to disclaim terminal parts of U.S. Patent No. 6,572,697 (hereinafter "the '697 patent").

Applicants respectfully request the terminal disclaimer be canceled or otherwise nullified.

The rejection as nonstatutory-type double patenting

A nonstatutory-type double patenting rejection was presented during prosecution of the pending '561 application in an Office Action mailed December 23, 2004. In the Office Action, it was stated that the '697 patent did not have identical conflicting claims but "they are not patentably distinct from each other [the '561 application] because all teach compositions comprising cement and fly ash and water in amounts overlapping the instantly claimed invention and process of making as well."

Claims of the pending '561 application

The '561 application, as claimed, is directed to a method of improving a hydraulic binder based coating formulation for coating a building board, the method comprises adding to said hydraulic binder a dewatering agent and water (see all allowed claims, Claims 1-9, 12, 16-20). After application of a thin slurry of the coating formulation to a building product, said slurry is dewatered through the building product (see all allowed claims, Claims 1-9, 12, 16-20). The thin slurry is 0.1 to 10 mm thick (Claims 1-9, 12, 16-19), is dewatered in at least about 120 seconds or less (Claims 16, 20). The thin slurry applied to the building product cures in air in at least about 48 hours (Claim 17).

In Claims 1-9, 12, 16-17 and 20, the dewatering agent comprises fly ash, wherein the fly ash further comprises two components with:

- a first larger size component of a 100 micron maximum size in an amount of about 10 to 60 wt% of the formulation based on total dry ingredients; and
- a second smaller size component of about 10 micron maximum size in an amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients.

In Claims 18 and 19, the dewatering agent comprises fly ash, wherein the fly ash further comprises two components with:

- a first larger size component of greater than 100 microns; and
- a second size component of about 10 micron maximum size in an amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients.

Claims of the '697 patent

Claims of the '697 patent are for a building material formulation to form a building product (Claims 1-13, 17-36, 45) and a method of forming a low density building material (Claims 14-16, 37-44).

Claims 1-16 require the following components in the formulation and method of making:

- a hydraulic binder;
- ground silica;
- cellulose fibers, wherein the cellulose fibers comprise greater than about 4% of the formulation by weight; and
- volcanic ash, wherein the volcanic ash is incorporated into the formulation in a quantity sufficient to lower the density of the building material to about 1.2 g/cm^3 or less, and wherein the volcanic ash maintains the moisture expansion of the building material at a level of about 0.17% or less

Claims 17-45 require the following components in the formulation and method of making:

- a hydraulic binder;
- ground silica;
- cellulose fibers, wherein the cellulose fibers comprise greater than about 4% of the formulation by weight; and
- hollow ceramic microspheres, wherein the hollow ceramic microspheres are incorporated into the formulation, in a quantity sufficient to lower the density of the building material to about 1.2 g/cm^3 or less, and wherein the hollow ceramic microspheres maintain the moisture expansion of the building material at a level of between about 0.13%-0.2%

Thus, claims of the '697 patent state that methods and formulations for the building product must comprise either volcanic ash or hollow ceramic microspheres in addition to a hydraulic binder, ground silica and cellulose fibers.

Methods for making formulations of the '697 patent state that the formulations are mixed in water to create a slurry (Claim 14, 15, 37, 38, 39, 44). The slurry is formed into a green shaped article to form the low density building material (Claim 14,37, 44). The green shaped article requires curing in an autoclave (Claims 16, 43). The green shaped article is processed from a slurry by a Hatschek sheet process (Claim 44). The formed building product is a board (Claim 44) or backerboard (Claim 45).

The '697 patent does not claim a dewatering agent, fly ash in any size or overlapping amounts or a coating

The '697 patent discloses nothing about a dewatering aid that comprises fly ash. In fact, the term "dewatering aid" appears nowhere in the specification or claims of the '697 patent. The '697 patent does not claim fly ash in amounts overlapping the '561 application. The '697 patent also does not claim two components of fly ash in overlapping amounts let alone one component of fly ash. In fact, the only reference to fly ash in the entire patent is at Col. 9, ll. 9-15, where it is stated that hollow ceramic microspheres, commonly known as cenospheres, are a coal ash by-product *separated from* fly ash by a floatation process. Claims of the '697 patent are also not directed to a coating. Rather, claims of the '697 are for methods and formulations for cementitious products that specifically form green shaped articles that require processing by a machine sheet or extrusion process and require curing by an autoclave.

Accordingly, claims of the '561 application are patentably distinguishable from those of the '697 patent. Thus, the '697 patent does not anticipate and is not obvious over the '561 application and cannot be relied on for an obviousness-type double patenting rejection because claims of the '697 patent neither teach nor suggest the claimed subject matter of the '561 application or are an obvious variant thereof.

The specification of the '697 patent may be used to understand the meaning of terms in the claims

The specification can be used as a dictionary to learn the meaning of a term in the patent claim. [*Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999)].

To understand the meaning of the term volcanic ash in the '697 patent, the specification is referred to wherein it is described, at Col. 4, ll. 47-55, that volcanic ash is a natural lightweight sand sediment derived from the magma of volcanoes during an eruption and formed by cooling of the high temperature magma, giving rise to a material comprising about 30 wt. % crystalline minerals and 70 wt. % amorphous volcanic ash glass. Volcanic ash has a typical bulk density of about 25-75 lbs/ft². Volcanic ash expands with heat, changing its morphology, creating a lighter material with a typical bulk density ranging from about 2-25 lbs/ft².

To understand the meaning of the term hollow ceramic microspheres in the '697 patent, the specification is referred to wherein it is described, at Col. 9, ll. 9-15, that hollow ceramic microspheres are commonly known as cenospheres and cenospheres are a coal ash by-product that is typically *separated from* fly ash by a floatation process where the spheres float to the surface of water from clarifiers, ponds or lakes (emphasis added).

To understand the meaning of the term building material in the '697 patent, the specification is referred to wherein it is described, at Col. 2, ll. 2-12, Col. 5, l. 32-Col. 6, l. 14; Col. 9, ll. 46-50, that a building material is formed from a green shaped article, is processed by a machine sheet or extrusion process, pre-cured for up to 80 hours, to form low density building materials, such as sheets, siding, roofing, trim, soffit, backerboard for tile underlay.

Conclusion

The '697 patent does not have identical conflicting claims to the '561 application. The '697 patent is also patentably distinct from '561 application because the '697 patent does not

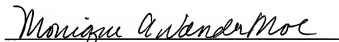
teach the same composition as claimed in the '561 application that comprises fly ash in two components, the '697 patent does not teach overlapping amounts of fly ash as claimed with the '561 application, the '697 patent does not teach the same process of making the composition of the '561 application.

Nullification or cancellation of a recorded terminal disclaimer erroneously submitted before the patent issues—for a terminal disclaimer directed to U.S. Patent No. 6,572,697—is herewith respectfully requested.

Applicants with this Petition submit the fees due under 1.182 and 1.17(f).

Should additional fees be due to grant nullification of the recorded terminal disclaimer, Applicants authorize the Commissioner to withdraw said fee, which is only for the grant of a nullification, to Gardere Wynne Sewell, Deposit Account No. 07-0153.

Respectfully submitted,


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Dated: February 27, 2009

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